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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

No. .....

LAWRENCE B. SCOTT,
Petitioner,

vs.

HAL W. HARMAN,
Respondent.

PETITION FOR WRIT OF CERTIORARI

Petitioner, Lawrence B. Scott, prays that a writ of certiorari issue to review the judgment of the Court of Appeals for the Sixth Circuit (R. 509) affirming the decision of the United States District Court for the Southern District of Ohio, Eastern Division (R. 456).

OPINIONS BELOW

The findings of fact and conclusions of law and opinion of the District Court appear in the record on pages 456 to 471. The opinion of the Court of Appeals appears in the record on pages 509 and 510.

JURISDICTION

The jurisdiction of this Court is invoked under c. 646, 62 Stat. 928, 28 U. S. C. A. 1254, of the Act of June 25, 1948. The judgment of the Court of Appeals, which the petitioner here seeks reviewed, is dated February 18, 1952. The petition is, therefore, timely.

QUESTIONS PRESENTED

1. In the repair of cracked castings, did it amount to invention to use malleable inserts applied in drilled openings across the cracks to hold the parts together when prior art devices showed the use of similar metal inserts, malleable and non-malleable, applied in drilled openings across cracks or joints as fastening devices for holding the separated parts together?

2. After the decision of this Court in A. & P. Tea Company v. Supermarket Corporation, 340 U. S. 147, should the Court of Appeals of the Sixth Circuit have affirmed the District Court's decision in this case, when the standard of invention was no higher than that of the invention involved in said A. & P. case?

3. May a patentee claim a combination of a device, and the material upon which the device works, or to which it is applied?

STATUTE INVOLVED

The questions here presented involve the construction of the patent law and more particularly one section thereof, R. S. 4886, 35 U. S. C. 31, the relevant portions thereof being as follows:

> "R. S. 4886—Inventions Patentable.
>
> "Any person who has invented * * * any new and useful art, machine, or composition of matter, or any new and useful improvement thereof * * * not patented or described in any printed publication in this or any foreign country * * * may * * * obtain a patent therefor."

STATEMENT

This is an action involving the alleged infringement of United States Letters Patent No. 2,142,896, issued to Hal W. Harman, for a thin cup-shaped metal fastening device for repairing cracks in castings (R. 398, 23, Figs. 5 and 6). The charge of infringement is based upon the use by the defendant of a substantially square bar fastening element also used for repairing cracks in castings, and illustrated in the record at page 406, 254, Figs. 1 to 4, inclusive. In the complaint as originally filed, plaintiff sued upon three patents, Nos. 2,011,484 (P. Ex. 1, R. 395, 22,), 2,142,896 (P. Ex. 2, R. 398, 23,) and 2,198,167 (P. Ex. 3, R. 402, 23,), involving in all some sixteen claims. Plaintiff was forced, however, in answer to defendant's motion for a bill of particulars (R. 4) to withdraw two of said patents, Nos. 2,011,484 (P. Ex. 1) and 2,198,167 (P. Ex. 3), and to limit his charge of infringement as to the six claims of the remaining patent now in suit, No. 2,142,896 (P. Ex. 2), to claims 1 and 2 which read as follows:

> "1. An improved locking fastener comprising a body of substantially thin metal composed of bulged and

connected restricted portions, said bulged portions being expansible by pressure, in combination with two separated parts of stock across which is drilled an opening substantially conforming in size and shape to said fastener, and into which opening said fastener is inserted and compressed.

"2. An improved locking fastener comprising a body of substantially thin metal composed of bulged and connected restricted portions, said bulged portions being expansible by pressure and adapted to be flattened out to increase the overall dimensions of the bulged and restricted portions, in combination with two separate parts of stock across which is drilled an opening slightly larger than the fastener and into which the fastener is inserted and expanded."

The use of metal fasteners applied across cracks or separated parts of materials, for holding the parts together, is old as shown in the prior art patents to Pierce (R. 418, 248,), Cordes (R. 409, 240), Richardson (R., 422, 248), Darrach (R., 436 248,), Roberts (R., 446, 248), Buckner (R., 416, 248), and Peckover (R., 440, 248). These prior art devices meet all the elements of claims 1 and 2 in suit in that they are made of metal, having bulged or enlarged portions connected by restricted portions, and are designed to be placed in drilled or recessed openings across two separated parts of stock, and are capable of being locked in place by pressure or force applied to the fastener.

In addition to being invalid in view of the prior art, claims 1 and 2 are also invalid in that they claim the fastening device in combination with the material upon which the fastening device is used.

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals erred:

1. In affirming the decision of the District Court holding that the fastening device of claims 1 and 2 amounted to invention.

2. In not holding that the claimed combination consists essentially of old elements which do not demonstrate such a degree of novelty as to constitute patentable invention over the prior art in the light of the strict standards laid down by this Court in Cuno Engineering v. Automatic Devices Corporation, 314 U. S. 84 at 91, and more recently in A. & P. Tea Company v. Supermarket Corporation, 340 U. S. 147 at 153.

3. In not holding that claims 1 and 2 of the patent in suit are invalid because they claim the fastening device in combination with the material upon which the fastener is used.

REASONS FOR GRANTING THE WRIT

1. The decision of the Court of Appeals affirming the District Court is in direct conflict with the applicable decisions of this Court.

2. The decisions of the Courts below affect a large portion of the casting repair industry, and will result in extensive litigation in other Circuits against users of devices similar to defendant's.

Wherefore, it is respectfully submitted that this petition should be granted.

Lawrence B. Scott
By JOHN J. MAHONEY
Attorney for Petitioner

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

No. .....

LAWRENCE B. SCOTT,
Petitioner,

vs.

HAL W. HARMAN,
Respondent.

BRIEF IN SUPPORT OF WRIT OF CERTIORARI

STATEMENT

The opinion below, jurisdiction, the questions presented, the statute involved, and the specifications of errors are stated in the petition.

The patent involved purports to cover a thin cup-shaped metal stamping (R. 398, P. Ex. 2, Figs. 5 and 6), for use as a fastening device in the repair of cracked castings. In the use of this device, overlapping holes are first drilled across and lengthwise of the crack in the casting (R. 398, Fig. 1.). The cup-shaped fastener, which is smaller than the holes, is inserted into the drilled opening and hammered down flat (R. 398, Figs. 2, 3 and 4) until it conforms to the outline of the drilled openings. This acts to lock the metal parts on

opposite sides of the crack preventing it from opening or expanding.

Defendant's device, which is alleged to infringe claims 1 and 2 of the patent in suit, is illustrated in Scott patent No. 2, 195, 741 (D. Ex. K, R. 406, 254 Figs. 1 to 4). It is a substantially square bar with undulating or irregular longitudinal sides which hold it in locked position when forced into the grooves having a complemental outline, and extending across or lengthwise of a crack in a casting.

SUMMARY OF ARGUMENT

1. The Harman patent in suit does not involve invention in view of prior art.

2. Claims 1 and 2 of the Harman patent in suit are invalid, because one may not patent a combination of a device, and the material upon which the device works.

ARGUMENT

1. The Harman patent in suit does not involve invention. All that Harman did was to drill holes in a casting across or lengthwise of a crack and insert a metal link therein to hold the part together. The idea of holding separated metal parts together by use of a metal link, or bar, inserted in a recess across a crack or joint is shown in a number of prior art patents. Some of such patents are as follows: Pierce (R. 418, 248), Richardson (R. 422, 248), Darrach (R., 436, 248), Roberts (R. 446, 248), and Peckover (R. 440, 248).

In order to strengthen its holding that the claims in suit were valid, the District Court found various faults with

these prior art references. It could not deny, however, that the said patents show the basic concept of the claims in suit, consisting of a metal link inserted or forced into a groove or recess across a crack for holding separated parts together.

In addition to the said prior art patents, various other methods of repairing cracks were known prior to Harman. The District Court stated in his opinion (R. 459) as follows:

> "That castings are subject to cracking is shown by the proof in the case and is, as well, a matter of common knowledge. Before Harman, there were several processes of repair used. One common process was by welding. Another was a 'shrink link'."

Harman, the patentee, on page 105 of the record, stated that the "shrink link" method consisted of taking a metal link, heating it, and forcing it into a drilled opening or recess across a crack. Upon cooling, the link shrinks and tends to pull the separated parts together. Thus, the admitted prior art "shrink link" met the basic elements of claims 1 and 2 in that it consisted of a metal link forced into a groove across a cracked casting to hold the separated parts together.

To the extent that the combination claimed in these claims may be merely combinations of old elements, it is clear that to be patentable, they must demonstrate something new and useful, either in result or the method of its achievement.

In Lincoln Engineering Company v. Stewart-Warner Corporation, 303 U. S. 545, 549, this Court held:

> "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

To the same effect is Toledo Pressed Steel Co. v. Standard Parts Inc., 307 U. S. 350.

It is submitted, therefore, that the claimed combinations consist essentially of old elements, and that the combinations do not demonstrate such a degree of novelty as to constitute patentable invention over the prior art, in the light of the strict standards laid down by this Court in Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84 at 91, and more recently in A. & P. Tea Company v. Supermarket Corporation, 340 U. S. 147 at 153. The fact that there may be some improvement in one or more of the old elements does not make the old combination repatentable as such (Bassick Manufacturing Company v. Hollingshead Company, 298 U. S. 415).

If the Court of Appeals, after having been reversed in the A. & P. case, had followed this Court's instructions in that case, by scrutinizing the combination claims 1 and 2 of the patent in suit, it is submitted that it could not have affirmed the decision of the District Court. In this case, as in the A. & P. case, the combination claims consist merely in an assembly of old elements, with no change in their respective functions. The Harman patent in suit has merely brought together segments of prior art and claims them in congregation as a monopoly.

2. In addition to being invalid in view of the prior art, claims 1 and 2 are invalid in that they claim the fastener device in combination with the material upon which the fastener device is used. If the patentee made any invention, it was in the fastener per se which the patentee describes (R. 399) on page 1 of the patent in suit, column 1, lines 46 to 52 as follows:

> "Referring more particularly to the drawing, and for the present to Figures 5 and 6, 12 designates gener-

> ally one of the improved locking fastenings which is made up of appropriate metal of desired gauge or thickness, and includes a number of bulged or enlarged locking parts separated by diminishing connecting necks."

They are unitary structures that may be sold in quantities like nails, screws or rivets. They are punched or stamped out of flat metal to the form shown in Figures 5 and 6 of the drawings. These facts are confirmed by statements in the specification of the patent (R. 399), page 1, column 2, lines 11 to 14. as follows:

> "In other words these fastenings are commercial units which are punched or stamped out of flat metal to the form shown in Figures 5 and 6 * * *."

In claiming this device, the patentee should not have included as elements of the combination the two separated parts of stock with which his device is used. In doing this he made the claim invalid.

That the material upon which the fastener device works is made an element of the combination claims is confirmed by the decision of the District Court who in analyzing the claims in suit said (R. 467):

> "It includes a metal 'Fastening' or lock having lobes or, enlarged or bulged portions connected by restricted portions. The other elements include two separated parts of stock which may be the parts on opposite sides of the crack in a casting."

One cannot have a patent for a combination of a device and the materials upon which the device works. This principle of law was enunciated in Morgan Envelope Company v. Albany Perforated Wrapper Paper Company, 152 U. S. 425, 431, in which this Court held as follows:

> "The first defense raises the question whether, when a machine is designed to manufacture, distribute, or

> serve out to users a certain article, the article so dealt with can be said to be a part of the combination of which the machine itself is another part. If this be so, then it would seem to follow that the log which is sawn in the mill; the wheat which is ground by the rollers; the pin which is produced by the patented machine; the paper which is folded and delivered by the printing press, may be claimed as an element of a combination of which the mechanism doing the work is another element."

The Court abstained from expressing an opinion on whether the paper roll could enter into a patented combination with the holder for it. But it intimated that it could not. It was not necessary for it to decide the case on validity because the facts of the case failed to sustain the charge of infringement.

A number of the United States Courts of Appeals and District Courts have interpreted the language of Mr. Justice Brown at page 431 in Morgan Envelope v. Albany Paper Co., 152 U. S. 425, as prohibiting the inclusion in a patent combination of a device, the material upon which the device works or operates.

In American Tobacco Company v. Streat, 83 F. 700, 704 (C. C. A. 4), the Court held that a leaf of tobacco could not be considered an element of the patent claim, stating as follows:

> "In our opinion, the leaf of tobacco called the 'second binder' is not the mechanical equivalent of the rolling apron described in the Streat patent, * * *. We do not think that an article manufactured in a machine in the manner and for the purposes contemplated when the machine itself was made can be held to be a part of the machine which so produces it." (Citing Morgan v. Albany, 152 U. S. 425, case as authority for its holding.)

In Union Paper Bag Machine Company v. Advance Bag Company, 194 F. 126 (C. C. A. 6), it was attempted to use a paper blank upon which the machine worked as an element of the combination but Judge Warrington, speaking for the Court, held as follows at page 139:

> "Counsel for complainant rightly concede that the use of the tang in question in place of the lower central gripper does not amount to the substitution of a mechanical equivalent; for that would be to treat the paper made into diamond folds by the machine, as an element of the patent. See Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, and language of Justice Brown at page 431, 14 Sup. Ct. 627, 38 L. Ed. 500, although obiter; American Tobacco Co. v. Streat, 83 Fed. 700, 705, 28 C. C. A. 18 (C. C. A. 4th Cir.)."

In re Hughes, 49 F. (2d) 478, C. C. P. A., the Court held as follows:

> "Appellant's claims involve several elements. Taking, for illustration, said claim 12, it will be observed that an attempted combination is made of the machine and the material or dye solvent used therewith. We have held in Re Smith, 36 F. (2d) 302, 17 C. C. P. A. 644, that a person may not patent a combination of a device and the material upon which the device works, nor limit other persons from the use of similar material by claiming a device patent. If the material which appellant uses here for printing is new to the art, then such material may be patentable; but he may not take advantage of this in applying for a patent upon a mechanism to apply it."

To the same effect are Burt v. Ritchie & Co., 251 F. 909 at 918, D. C. E. D. N. Y.; In re Smith, 36 F. (2d) 302, C. C. P. A. 1929; In re Hodler, 73 F. (2d) 507, C. C. P. A. In Motion Picture Patents Company v. Universal Film Manufacturing Company, 243 U. S. 502 at 512, this Court made it clear that materials with which or on which a

patented device works are no part of the combination which produces the patented result, stating as follows:

> "Plainly, this language of the statute and the established rules to which we have referred restrict the patent granted on a machine, such as we have in this case, to the mechanism described in the patent as necessary to produce the described results. It is not concerned with and has nothing to do with the materials with which or on which the machine operates. The grant is of the exclusive right to use the mechanism to produce the result with any appropriate material, and the materials with which the machine is operated are no part of the patented machine or of the combination which produces the patented result."

In the "Dry Ice" case, Carbice Corporation of America v. American Patents Development Corporation, 283 U. S. 27, a patent (No. 1,595,426) on a shipping package was involved. Claim 6 of the patent was for a transportation package including in the combination, material to be refrigerated, and frozen carbon dioxide as a refrigerant. The claim made the carbon dioxide an element of the patented combination but this Court refused to give effect to the patent, and virtually held the patent invalid by refusing to hold the defendant guilty of contributory infringement. An attempt was made to distinguish the case from prior decided cases but this attempt met with failure as this Court said:

> "Plaintiffs seek to distinguish the Motion Picture Patents Co. Case from that at bar, by pointing out that there, as in Henry v. A. B. Dick Co. 224 U. S. 1, 56 L. ed. 645, 32 S. Ct. 364, Ann. Cas. 1913D, 880, the unpatented supplies, over which the licensor sought to extend its monopoly, were merely used in the patented machines, whereas here the unpatented refrigerant is one of the necessary elements of the patented product. And to distinguish the case at bar from

> Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co. 152 U. S. 425, 433, 38 L. ed. 500, 503, 14 S. Ct. 627, it is pointed out that the Carbice Corporation is furnishing not a passive element in the combination, like the paper in the Morgan Envelope Co. Case fixture, but the dynamic element which produces refrigeration. These distinctions are without legal significance."

The Court thereupon denied the patentee relief even though the refrigerant material contained in the package constituted an element of the combination claim.

It is submitted that the Courts below should have held claims 1 and 2 in suit invalid because they claim the fastener device in combination with the material upon which the fastener device is used. This may not be done. It is submitted, therefore, that these claims are invalid.

CONCLUSION

Wherefore, it is respectfully submitted that this petition for writ of certiorari should be granted.

Respectfully submitted,

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No. 713.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

LAWRENCE B. SCOTT,
Petitioner,

vs.

HAL W. HARMAN,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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HAL W. HARMAN,
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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

In response to the petition for writ of certiorari to the United States Court of Appeals for the Sixth Circuit filed herein, the respondent, Hal W. Harman, by his attorneys, respectfully requests that the petition be dismissed.

COUNTER-STATEMENT OF QUESTIONS PRESENTED.

1. In an ordinary patent case, with the usual issues of invention, construction of claims and infringement, and involving merely an interlocutory order, will this court grant a writ of certiorari to review the concurrent findings of the lower courts on such order?

2. Where there are concurrent findings of the lower courts that the claims in issue are valid in law, and that no one prior to the patentee-respondent had conceived of a combination which would give the patentee's result, that the patentee in suit, if not indeed a basic one, at least is one of high rank (R., 461, 509, 510), will this court review the decision in the absence of any showing in the record that such findings are clearly erroneous?

STATEMENT.

History of Patent in Suit.

Petitioner, in his brief, states the respondent was forced, in answer to a motion for a bill of particulars, to withdraw two of said patents (Exhibit 1 and Exhibit 3) from the complaint. Respondent was not forced to withdraw the patents in question because of said motion. The record shows that the motion in question was filed August 3, 1944 (R., p. 2). The answer to the motion for a bill of particulars was filed November 25, 1946 (R., p. 4). During this period of over two years, the United States was actively engaged in World War II and the respondent here was serving with the United States Navy as a civilian expert in the salvage and repair of naval vessels through the application and use of the locking fastener disclosed in the

patent in suit. Witnesses originally available in 1944 were scattered by the war and not available in 1946. Having a previous adjudication sustaining his earlier patent, No. 2,011,484 (Exhixit 1 (R., p. 5), respondent decided to proceed only on his second and later patent, No. 2,142,896 (Exhibit 2).

The patent in suit (Exhibit 2) is directed to an improvement in fasteners, or what is known in the trade as locks. The application for the patent was filed August 7, 1937 and the patent issued January 3, 1939 having six claims allowed, claims 1 and 2 of which were sued upon in the court below.

The invention comprises a metal fastener or lock for repairing broken castings or for joining two pieces of metal stock (Exhibit 2). The lock is formed with lobes, which are described as enlarged or bulged portions connected by restricted portions. An opening is drilled in the casting across the fissure substantially conforming in size and shape to the lobe type lock. The shoulders on the lobes of the lock abut the complementary shoulders in the drilled opening. The lock is formed of ductile material and is hammer-drawn cold in the opening to compress and expand the lock whereby the side walls of the lock, including the complementary shoulders, form a seal with those of the opening. The lock is thus held in position and prevents relative movement between the joined parts of stock (R., p. 467, No. 8).

The fastening or lock must have sufficient thickness or depth so that after it is compressed or hammer-drawn cold, it will not tear due to strains placed upon it and must be thin enough so that it can be compressed and thereby expanded transversely by hammer blows so that the shoulder lobes intimately engage the shoulders of the drilled design or recess (R., 467, No. 9).

There must be intimate contact of the shoulders of the lobes and the complementary shoulders of the recess throughout the depth of the lock so that the spreading strains are uniform throughout the depth of the lock, since it is desirable to restore the tensile strength at the crack or fissure in the casting. The depth to which the lock can be compressed and expanded, by hammer blows, is limited. Therefore, if the casting, to be repaired, is thicker than the practical depth of expansion of the lock by hammer blows, a plurality of locks are each expanded by compression in laminated form in the recess whereby each of the shoulders of each of the locks is expanded, throughout the depth thereof, into intimate metallic contact with the respective complementary shoulders of the drilled recess across the fissure (R., p. 468, No. 10).

Petitioner's Fastener (Lock) is for Repairing Broken Castings.

Petitioner, at the time of filing suit, was doing business in repairing cracked castings under his own name and was a party to the business conducted under the name of "Metalock Company" and "Metalock Casting Repair Service", a licensee of petitioner. The petitioner has other licensees throughout the United States who repair broken castings and in such repairs use locks under the trade name "Metalock", all of which locks are manufactured by Metalock Casting Repair Service in Columbus, Ohio (R., pp. 221, 222, 231).

Petitioner and his licensees are now in the business of repairing cracked castings using the metal lock known to the trade as "Metalock". Examples of the locks or fasteners petitioner made and sold are Exhibits 4, 5, 6, 7, 10, 11, A and Q (R., p. 467). Petitioner's fasteners or locks,

as exemplified by Exhibits 4, 5, 10 and 11 perform the same work in substantially the same way and accomplish substantially the same result as the fasteners or lock of the patent in suit (R., p. 470, No. 28).

Petitioner Learned of Respondent's Invention in Confidence and Violated That Confidence.

The petitioner, Scott, while he was employed by the respondent, had certain territories in which he acted as respondent's agent and in which he had the right to license others to do the work. Occasionally the petitioner came to the El Paso shop where the respondent was using his new lock. At the time respondent was using his invention petitioner saw the respondent demonstrate it (R., p. 462).

Scott Went Into Business for Himself and Used Harman's Invention About One and a Half Years Before Harman's Patent Issued.

Scott went into business for himself in July, 1937 and built up a casting repair service, using locks which the trial court held to be infringements of the patent in suit. This patent of Harman's was not issued until January, 1939, the application having been filed on August 7, 1937, just about the time Scott went into business for himself (Exhibit 2). Harman was thus at the mercy of Scott since Harman could do nothing to stop Scott's infringement until the patent issued. Shortly after the patent issued, Harman notified Scott of that fact and that his use of the lock was an infringement (R., p. 5). This notice was dated February 27, 1939 and sent to Scott in San Antonio, Texas. Thereafter Scott left Texas and started up in business as the Metalock Repair Service in Columbus, Ohio (Exhibit 29).

In the meantime the United States, as of December 7, 1941, had entered into World War II. Harman then became actively engaged with the United States Navy in the 11th Naval District as a civilian expert in the repair of broken castings in naval vessels through the use of his patented lock. When Harman learned of the new activity of Scott in Columbus, Ohio, he investigated and gathered what evidence he could. Suit was filed in Columbus, Ohio, June 19, 1944. Harman's counsel deemed it advisable to file the suit then because of the six-year statute limitations (35 U. S. C., 70; R. S. 4921) governing recoveries for infringement, the patent having issued in January, 1939. However, the war activities prevented proceeding even with the pleadings for another two years; i.e., until November, 1946 (R., pp. 2 and 4).

Utility of Invention of Patent in Suit.

The claims in suit are directed to a new product, i.e., a novel combination of elements which produce a new and useful result. The form of the claims in the patent has the approval of the Patent Office and the lower courts.

The present invention is particularly useful in the repair of broken castings. Cast metal quite often cracks due to internal stresses in the metal, and quite often castings crack due to overheating of the same or the quick cooling of the same after being overheated. Water-cooled engine blocks are often cracked due to the freezing of the water therein.

Since the advent of the forming of metal by casting, it has been desirable to repair cracked castings. Many attempts were made to make these repairs. Some broken castings could be welded, and some could be fastened to-

gether by using a shrink link or key. Welding and shrink key methods have limited use.

In the welding method, super-heating of the casting would cause it to warp and in most instances this would require re-machining of the casting after it had been repaired. Furthermore, since super-heating was necessary, it was necessary to dismantle the entire machinery to remove the casting which had to be super-heated.

The shrink key method required a high degree of skill, was very costly and in many cases was impractical because the shank of the link upon shrinking in the channel, would provide a gap for the escape of fluid. Moreover, upon shrinking of the key, high internal stresses would be set up in the key for holding the cracked parts together and in many instances the key would break.

Another method which Harman and Scott practiced was the lacing process using studs or bolts as explained in the Harman Patent No. 2,011,484 (Exhibit 1).

A manual (Exhibit 12) of disinterested parties to this suit, namely, officers in the Philadelphia Navy Yard, had this to say about the known processes and the process employing the patented locks which Scott and Harman use, page 14:

> "Cold metal repair process of the stud and key type have been used unsuccessfully for years. After considerable research, this new cold metal process was developed."

The "new cold metal process", referred to, utilizes and finds its entire success in the invention of the patent in suit, either in the form manufactured by Harman or the form manufactured by Scott, as is clear from the manual and which we will discuss more in detail later.

Mr. Harman, who had had wide experience in the repair of castings, testified as follows (R., 104-105):

"* * * Welding is not satisfactory in many cases and in most cases I am speaking of fusion welding. Fusion welding is the actual melting of cast iron and putting it in other cast iron and should not be confused with bronze welding and other kinds. I am talking about fusion cast-iron welding, which is actually cast-iron welding. Now, cast-iron because it must be preheated and brought to relatively high temperatures and cooled slowly after welding the high heat over the entire casting will produce a lot of warpage and the casting will have to be machined afterwards to restore it to use. In many cases all that expense is gone to and the casting only lasts a short while after it is welded and it is broken again due to stresses left in from the welding. It would prove too expensive in most instances to attempt reclamation of castings along those lines. There was a need for a simpler way of reclaiming castings, a way that would be quicker, more sure of results, and that is what I was trying at the time this invention came out.

Q. Now with respect to the shrink link. A. The shrink link is a link that is put across the break in the casting. It could be in the form of a T. Cut a channel this way. Sometimes it has a straight T here like that and the crack would be here. They make a link that is shorter than this channel. The link has the T in it and they hit and expand that link until its length will allow it to drop into the channel. The link then shrinks as it cools and draws the crack together. In doing so, it sets the original stress in that casting that broke it, and it isn't possible for anyone to put in a series of those links and have them all uniform, have the tension uniform on all of them. Therefore, there is one or two, or maybe no more than three where there is a large use of those links that have all the strain on them because they would shrink tighter than the others and that would throw a stress spot at one place in the casting and break it again.

Q. Can you explain in a short manner what your invention does on the lock—your lock invention does?

A. Yes. You drill a design. You may call them enlarged or bulged places and restricted places all connected together and in them you tighten a lock fastener by hammering it in cold."

Although these prior art processes were known, there were millions of dollars' worth of castings discarded each year because of the fact that the welding and other known methods were impractical. Mr. Kirby (R., 74) testified that, before the Harman invention, he had thrown away thousands of dollars' worth of cast iron because he was unable to repair them. Mr. Kirby is merely one of the many thousands of repair men dealing in castings.

Scott also testified that "broken and useless" castings were repaired (R., 231) by using locks. The castings were made "Tight to make it a sealed fit and also the alignments were retained and were restored where the casting was broken without machining." Without the requirement of re-machining, high repair expenses are eliminated.

Harman's invention is practiced without the use of extraneous heat. In practicing the present invention, the broken casting can usually be repaired without dismantling any of the machinery, of which the casting is a part. If dismantling is necessary, only such dismantling need be carried out to make the crack accessible, that is, it is not necessary to remove the casting from the machinery as was necessary for super-heating prior to welding.

The lock or fastener per se, of the patent in suit, comprises a body of ductile metal containing nickel and iron and known to the trade as Invar. This metal is shaped into bulged or enlarged portions and connecting restricted portions. The metal, being ductile, is expansible by pressure. A recess is fashioned across the crack in the casting to be repaired. This recess substantially conforms

in the size and shape to the fastener or lock. The lock is then placed in the recess and hammered to force the lock into place and to compress and spread the lock so as to firmly grip with the casting. This hammering increases the tensile strength of the lock metal by cold drawing it. The peripheral portions of the lobes, between the restricted part of the lock at the extreme side edges of the lobe, provide shoulders which hold the parts of the casting in place.

These locks are merely hammered in place to compress and thereby expand the same and no extraneous heat is necessary to carry out the operation of repairing the casting.

In order to insure the necessary tensile strength at the repair, it is desirable to superimpose or laminate a plurality of these locks in a relatively deep recess. Such structure is shown in Fig. 4 (R., 398) of the drawings in the patent in suit. As explained in the patent (R., 401) column 2, line 44, the fasteners or locks are of "thin material as compared with the depth of the stock, requiring a plurality of fasteners to be overlaid one upon the other to fill the openings", the openings being the recesses formed in the casting being repaired.

By this new invention, the patentee can repair in hours that which took days to accomplish by any of the old methods. The great need for a substitute for the slow and costly welding process is clearly brought out by the witness Stembridge who testified that in 1937 he was garage foreman for the El Paso Electric Company, a company which operated the buses for the city of El Paso, Texas (R., 302):

> "Well we had several blocks there, motors, and different parts of motors where there would a crack come in it, and ordinarily we had been taking the motor completely out of the car, stripping it down, having to preheat the block and hold it at that heat while

the weld was being done, and that made it necessary to tie up the car for several days, and at that time, the same as now, we were trying to keep the equipment rolling, keep it in service and not tie it up any longer than possible, and on some of these cracks we had Mr. Harman to repair them by his process which took about three or four hours; in other words, the bus could go out on the run in the morning and come in off of that run and he would repair it and it would be ready to go out in the afternoon. That was the main reason that I had the kind of work done that he was doing."

SUMMARY OF ARGUMENT.

1. This is an ordinary patent case having the usual issues of invention, construction of claims and infringement, involves merely an interlocutory order and no conflict of decisions, and consequently is not of sufficient general importance and gravity to warrant review by the Supreme Court.

2. The petition filed herein should be dismissed because the careful and detailed findings of fact made by the trial court, and concurred in by the Circuit Court of Appeals, depended essentially upon an appreciation of the evidence, and such findings are not shown by the record to be clearly in error.

ARGUMENT.

1. The Petition For Writ of Certiorari Should Be Dismissed.

All of the findings in this case are clearly contra to the petitioner's stated contentions and warrant a finding in favor of the respondent here (R., 466-471). Accordingly, the petition should be dismissed in view of the findings, none of which are shown to be in error, and which depended essentially upon an appreciation of the evidence. **Houston Oil Co. v. Goodrich**, 245 U. S. 440.

Moreover, the petition here should be dismissed for the same reasons stated by this court in **Layne and Bowler Corp. v. Western Well Works**, 261 U. S. 387, 392 and **Magnum Import Co. v. Coty**, 262 U. S. 159, 163. The record shows this to be an ordinary patent case involving primarily questions of fact and principles, the settlement of which are of importance only to the parties, as distinguished from that of the public in general. Jurisdiction to bring up cases from the circuit courts of appeal by certiorari was given for the two purposes of securing uniformity of decisions in the circuits and of having questions of importance decided by this court when desirable in the public interest—not for the purpose of giving the defeated party another hearing. In the case at bar there are no conflicting decisions in the circuits—all that is involved is an interlocutory order of the trial court.

There is no important issue of general patent law under Sec. 4886, Rev. Stats. (35 U. S. C. 31) as contended by the petitioner herein. The record in this case shows it to be an ordinary patent case, with the usual issues of invention,

construction of claims and infringement. Such a case will not be brought up to this court by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent. **Keller et al. v. Adams-Campbell Company, Inc.**, 264 U. S. 314, 319.

It was similarly held in **General Talking Pictures Corp. v. Western Electric Co.**, 304 U. S. 175 that a writ of certiorari will not be granted by this court in a patent infringement case to review questions of anticipation and invention where there is no conflict between the decisions of the circuit courts of appeal. This latter case also held that concurrent findings of the district court and the circuit court of appeals on questions of fact are not disturbed unless plainly without support in the evidence. In the case at bar, the petitioner has made no showing that the findings of fact, as found by the trial court and affirmed by the court of appeals, are plainly without support in the record.

The exceptional power to review, upon certiorari, a decision of a circuit court, rendered upon an appeal from an interlocutory order, as in the case at bar, is intended to be and is sparingly exercised and then only in cases of peculiar gravity and general importance, and in order to secure uniformity of decision. The fact that the decree sought to be reviewed is not a final one furnishes sufficient ground for refusing the petition. **Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.**, 240 U. S. 251, 258. The case at bar should be governed by the principle established and applied by this court in the latter case.

2. Claims 1 and 2 of the Patent Define Patentable Subject Matter.

As stated by petitioner, the problem of joining two pieces of metal or other materials, has always been faced by man. But no one prior to Harman provided the successful way of inexpensively and quickly joining two pieces of metal such as the broken parts of a casting.

The prior art is replete with fasteners, but none shows the invention defined by claims 1 and 2 of the patent in suit. Although the claims in suit do not specifically state that the two separate parts of stock, which are to be joined, are formed of metal, we need merely refer to the specification of the patent to determine what is meant by "two separate parts of stock" (R., 399, column 1, lines 6, 7, 13, 18, 30, 40; etc.; column 2, lines 39, 43, etc.). Moreover, the lock per se 12, or body of metal, is defined as compressible in claim 1 and expandible in claim 2. Obviously the "parts of stock" must be of sufficiently hard material to form a solid bottom for the lock. Otherwise the lock would be driven, for example, down in the wood during the hammering and would not be compressed or expanded. Furthermore, this is the first attempt to attack the claims in this manner and it must fall because the prior art does not disclose the invention.

Scott was asked by the trial court if counsel could pick out, from the prior art, those patents which he deemed anticipated the patent in suit (R., 259), and counsel picked out the following (R., 270):

Exhibit	Patentee	Number	Date
P-5	Williams	1,201,008	July 4, 1935
P-1	Meldrum	1,742,044	Oct. 10, 1916
P-2	Buckner	154,580	Dec. 31, 1929
P-3	Pierce	1,802,829	Sept. 1, 1874
P-4	Richardson	793,958	Apr. 28, 1931
1	Harman	2,011,484	Aug. 13, 1935

Counsel for Harman in his main brief before the trial court, narrated these patents for the benefit of the court. Seeing that these patents could not be used to anticipate the invention, Scott shifted to another group of patents in his brief before the trial court. The new group included:

Exhibit	Patentee	Number	Date
P-7	Schranz	1,905,653	Apr. 25, 1933
P-8	Lovepoy	1,561,872	Nov. 17, 1925
P-9	Darrah	1,417,039	May 23, 1922
P-10	Peckover	390,034	Sept. 25, 1888
P-11	Peckover	381,811	Apr. 24, 1888
P-12	Roberts	1,441,274	Feb. 20, 1923
P-6	Williams	1,338,411	Apr. 27, 1920

Then before the court of Appeals, Scott again shifted his group of patents which are alleged to anticipate the invention and selected the following group:

Exhibit	Patentee	Number	Sept. 25, 1888
P-2	Buckner	154,580	Apr. 24, 1888
P-1	Meldrum	1,742,044	July 4, 1904
P-3	Pierce	1,802,829	Date
P-8	Lovepoy	1,561,872	Sept. 1, 1874
P-7	Schranz	1,905,653	Dec. 31, 1929
P-5	Williams	1,201,008	Apr. 28, 1931
P-6	Williams	1,338,411	Nov. 17, 1925
P-9	Darrah	1,417,039	Apr. 25, 1933
P-12	Roberts	1,441,274	Oct. 10, 1916
L	Cordes	1,165,155	Apr. 27, 1920
P-10	Peckover	390,034	May 23, 1922
P-11	Peckover	381,811	Feb. 20, 1923
P-4	Richardson	793,958	Dec. 21, 1915

Now the petitioner in his brief before this Court, is relying only upon Pierce, Richardson, Darrah, Roberts and Peckover (Brief, p. 7).

3. **Prior Art.**

Pierce P-3 (R., 419 and 469).

The Pierce paten shows a resilient link which is obviously formed of hardened metal. It comprises lobes 10 and 11 which are connected together by a narrow interconnecting portion 13. The interconnecting portion 13 is arched as is shown in Fig. 2. Quoting from page 1 of this patent, line 87 (R., 419):

> "Before the link is applied to the machine elements the arched portions 13 are slightly shorter than the corresponding narrow portions of the recesses and the links will fit into the recesses **only** upon being stretched or deformed to an extent sufficient to separate the enlarged end portions 11 and 12 to make them register with the enlarged end portions of the recesses. This can be accomplished by depressing or flattening the arched portions 13 until the links **snap** into place in the recesses."

Obviously the link must be formed of hard material (as distinguished from ductile or malleable material) in order to be resilient. There is no suggestion whatsoever in this patent of compressing or expanding the link by deformation of the material of the link by hammer blow action.

Darrah P-9 (R., 436).

Darrah is directed to a method of making shims. The body portion 3 of the shim is provided with open side recesses or notches 4 which receive the tongues 2 of the bearing metal 1. The bearing metal is very soft (Babbitt). A shim is employed as a spacer which is clamped by bolts between two bearing retainers. The edge of the bearing metal, opposite the tongues 2 embraces the rotating shaft. Therefore, the bearing metal 1 is held in place by the bear-

ing retainer bolts and is prevented from displacement by the rotating shaft. There is no suggestion whatever in this patent of utilizing the bearing metal as a lock across the fissure of two pieces of metal.

Roberts P-13 (R., 446 and 469).

Roberts' patent was cited by the Patent Office and overcome by the applicant. Roberts is directed to **welding** locks in position. In each embodiment, including Fig. 10, the locking members 4, are held in position by welding only. Roberts states (R., 449, line 67):

> "The edges of each plate and the apertures are bevelled as shown at 1a, 5a, respectively, and the edges of the locking pieces 4 are also bevelled as shown at 4a, Fig. 3, so that when the plates and locking pieces are assembled a bed or channel is formed to receive the metal added by the welding operation."

It is not only the costly welding that patentee eliminates but also the great cost of tearing down the machinery to remove the cracked casting, the building of an improvised oven in the field for slowly heating the casting to be welded which heating must be gradual, particularly for large castings which will otherwise crack beyond repair (sometimes this heating requires days), warping during heating and welding, gradual cooling, and then often remachining because of warping. Also, by the present invention, repairs can be made which are impossible to make by welding.

Peckover P-10 (R., 439) **and P-11** (R., 443).

Both Peckover patents were cited by the Patent Office and overcome by applicant. The earlier of these two patents (Exhibit P-11) is directed to a removable saw tooth, having grooves b′ (Fig. 3), or the equivalent, a flange (Fig. 7), for retaining the tooth in the saw blade A. Only one saw tooth can be inserted in a single opening on the blade.

The second Peckover patent (Exhibit P-10, R., 441), shows a key E having grooves, like b′ in Exhibit P-11, for holding the same in position. Only one key can be inserted in the stock.

Obviously, structures of the Peckover patents could not be used for repairing a deep crack in a casting.

The Patent Office recognized the dissimilarity of the problem the patentee solved and the disclosure of Peckover. It is interesting to note that these patents issued in 1888, yet between 1888 and the time that the instant inventor made his invention, millions of dollars' worth of castings were scrapped because they could not be repaired by the then known locks and processes.

Richardson P-14 (R., 422 and 469).

The Richardson patent is entitled "Method of Making Brazed Joints". R., 423, line 10, reads:

> "This invention has relation to a method making brazed joints, * * *".

Line 17 reads:

> "My invention is particularly applicable to the brazing of broken joints in cast-iron or high-carbon steel."

The brazing material in each figure is designated by the letter B. In Fig. 2, the pieces 7 and 8 are welded together, and brazing material is also indicated at 4. A reinforcing piece 5, having spaced bulged portions and a connecting neck is socketed in suitable recesses 6—6 in the pieces 7 and 8. The patentee states (R., 423, line 100):

> "* * * this reinforcing piece 5 being made of material of such character that the brazing material will flow freely over its surface during the brazing operation and will tighly braze it in the recesses 6—6".

The patentee states (R., 424, line 31):

> "The particular material which I prefer to employ for the joining strips and for the reinforcing pieces is steel, * * *".

as distinguished from malleable material which can be compressed and expanded.

The Claims in Issue Are For a New Combination of Elements.

Claims 1 and 2 of the patent in suit include a limitation not disclosed nor suggested by the prior art. These claims are limited to the fastener (lock) "compressed" (claim 1), "expanded" (claim 2) in the opening. They call for a new combination of elements. None of the patents in themselves or in combination teaches or suggests the combination. The question immediately arises, if such patents teach the invention, why wasn't it practiced? Castings have been cracking ever since they were first used. Why were millions of dollars' worth of castings scrapped? Why make repairs which required days and weeks when they could have been made in hours? Why did the skilled Mr. Scott wait until he was taught how to use the invention by the instant patentee?

The present case falls squarely under the doctrine of **Diamond Rubber Co. v. Consolidated Rubber Tire Co.**, 220 U. S., 428 at 434, 435:

> "Many things, and the patent law abounds in illusthations, seem obvious after they have been done, and, 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of the inventive genius.' Pearl v. Ocean Mills, 2 Bann. & Ard., 469, Fed. Cas. No. 10,876, 11 Off. Gaz., 2. Knowledge after the event is always easy, and prob-

> lems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skilful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. And it recognizes degrees of change, dividing inventions into primary and secondary, and as they are, one or the other, gives a proportionate dominion to its patent grant. In other words, the invention may be broadly new, subjecting all that comes after it to tribute (Chicago & N. W. R. Co. v. Sayles, 97 U. S., 554, 556, 24 L. Ed., 1053, 1054); it may be the successor, in a sense, of all that went before, a step only in the march of improvement, and limited, therefore, to its precise form and elements, as the patent in suit is conceded to be. In its narrow and humble form it may not excite our wonder as may the broader or pretentious form, but it has as firm a right to protection."

and in the recent decision in **Goodyear Tire and Rubber Co., Inc., et al. v. Ray-O-Vac Co.**, 321 U. S. 275, Justice Black stated:

> "Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention."

The novel combination cannot be anticipated by piecemeal selection of component parts of the combination from a number of prior art patents, which prior art patents did not themselves solve the problem.

A leading case which laid down this principle is **Parks v. Booth**, 102 U. S., 96, 104, wherein the United States Supreme Court said:

> "Where the thing patented is an entirety, consisting of a separate device or a single combination of old elements incapable of division or separate use, the respondent cannot make good the defense in question by proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part, in another, and so on indefinitely, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant. Bates v. Coe, 98 U. S., 31."

Other leading cases illustrating the application of this principle are **The Barbed Wire Patent**, 143 U. S. 275 and **Keystone Manufacturing Co. v. Adams**, 151 U. S. 139.

In the case of **Metropolitan Device Corporation v. Cleveland Electric Illuminating Co.**, 36 F. (2d), 477, 479, C. C. A. 6, 1929, the Court said in holding a combination patent valid and infringed:

> "Nor was plaintiff's invention anticipated by the prior art. The cable, the insulating compound, the sleeve with its soldered joint, and possibly the cable joint construction, were all old, but they were not old in combination. In the new combination they produced a new result and therefore were not anticipated. Webster Loom Co. v. Higgins, 105 US 530, 591, 26 L. Ed. 1777; Detroit Carrier & Mfg. Co. v. Dodge Bros., 33 F (2d) 743, 747 (CCA 6); Michigan Carton Co. v. Sutherland Co., 29 F (2d) 179, 183 (CCA 63; Ferro 669 (CCA 6); Kellogg Switchboard & Supply Co. v. Concrete Constru. Co. v. Concrete Steel Co., 206 F 666, Dean Elec. Co., 182 F. 991, 998 (CCA 6)."

A & P and Cuno Cases Not Applicable.

Obviously, in view of the findings of fact made in this case (R. 466-471), the principle of law established in the

A & P Tea Co. v. Supermarket Corp., 340 U. S. 147 has no application. In that case the trial court explicitly found that each element in the device was known to the prior art. The court did not find that the old elements performed any additional or different function in the combination than they performed out of it. That court held that the grocery counter with an extension to receive a bottomless open-ended tray for pushing groceries along the counter constituted a novel feature and a new and useful combination. The extension was not mentioned in the claims, however.

There was no problem in that case as was solved by the patentee-Harman in the case at bar. Neither were there any findings in the A & P case, such as in the case at bar, to support the finding of invention and the further finding that "the patent in suit, if not indeed a basic one, at least is one of high rank." (R. 461).

Similarly, the **Cuno Engineering v. Automatic Devices Corporation** case (314 U. S. 84) can be distinguished from the case at bar on the facts. In that case a well-known thermostatically controlled heating unit was incorporated in an automobile cigar lighter having a removable plug bearing the heating unit, which was also old and well known in the prior art. This Court held that this was a combination of old or well-known devices requiring only the work of a mechanic skilled in the art to assemble. Such a case is clearly distinguishable from the one at bar where it was explicitly found that the invention is more than and beyond the ordinary and expected mechanical or engineering skill of persons skilled in the art of repairing cracked castings (Finding No. 11 R. 568).

Claims Not Directed To A Machine and Its Product.

The argument, now advanced by the petitioner, that the claims in suit are invalid because they claim a fastening device in combination with the material upon which the fastener is used, is not based upon fact. The lower courts did not make any such finding, and neither does the record support any such contention. Findings of fact Nos. 8 and 27 speak for themselves. (R. 467, 470) All of the cases cited by the petitioner, of which **Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co.** (152 U. S. 425) is an example, are not applicable to the case at bar since the claims in those cases were all directed to an attempt to claim the machine per se and the article produced by the machine, or worked upon, as a combination. It is to be noted that in each case the machine is an entity in itself—a completely operative device separate from the product or work, i.e., independent thereof. In the instant case the lock of the patentee-respondent is merely one element of a combination of elements that cooperate to produce a new product. (Finding No. 27 R. 470).

In **Continental Paper Bag Co. v. Eastern Poper Bag Co.**, 210 U. S. 405, the patent claims were for a mechanical combination of parts for folding a bag. The lower courts designated the invention as one entitled to "high rank." The Supreme Court held that where both of the lower courts find the inventor has done what has not been done before, and that there has been infringement, it will not disturb their findings unless they appear to be clearly wrong. The case at bar should be governed by these principles.

CONCLUSION.

1. This is an ordinary patent case involving only the usual issues, an interlocutory order and no conflict of decisions.

2. The concurrent findings of the lower courts are all supported by the record, and not shown to be in error.

3. Claims 1 and 2 of the patent in suit disclose patentable subject matter and are valid when tested by the principles of this Court as established in **Parks v. Booth**, 102 U. S. 96, 104; **Diamond Rubber Co. v. Consolidated Rubber Tire Co.**, 220 U. S. 428 and **Keystone Mfg. Co. v. Adams**, 151 U. S. 139.

4. The decision of the Court of Appeals affirming the District Court is not in conflict with any applicable decision of this Court.

For the reasons stated, the respondent prays that the petition filed herein be dismissed with costs.

Respectfully submitted,

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